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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,801	02/22/2002	Richard Jupe	4981*339 (PM-1979)	9921

7590 07/25/2003

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EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/080,801	JUPE ET AL.	
	Examiner	Art Unit	
	Dionne A. Walls	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 21-31 and 35-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 13-15 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 8-10, 12 and 16-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

An application in which the benefits of an earlier application (in this case, the Provisional Applications 60/270,698 and 60/292,426) are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). Correction is requested.

Election/Restrictions

1. Applicant's election with traverse of the Restriction Requirement in Paper No. 5 is acknowledged. The traversal is on the ground(s) that all the claims are closely related and properly classified in Class 131, and that similar fields of search much be made and similar issue addressed in determining patentability. This is not found persuasive because, as stated in the Restriction Requirement, the inventions are related as combination-subcombination, the requirements of the latter not being required by the former. That, coupled with the fact that the subcombination has utility by itself, justifies the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claim 5 recites the limitation "said filtration" and "said adjacent upstream end portion" in lines 3-4 of the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim Objections

5. Claims 6 and 14 are objected to because of the following informalities:

In claim 6, insert the word – is -- after the word "ventilation",

In claim 14, line 3, "85" should be changed to – 85% --.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 11, 13-15, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry et al (US. Pat. No. 5,568,819).

Gentry discloses all that is recited in the claims (See fig. 11 and cols. 2,5,8 and 10; Note: "carbon-containing filter segment 232" corresponds to the claimed "bed of adsorbent"), except that it may not specifically state that in this particular embodiment, a flavor-releasing component is located in the filter segment which is downstream of the bed of adsorbent. However, in col. 10, lines 1-2, it does state, generally, that the filter materials which are used in the inventive filter can have flavoring agents incorporated therein. Therefore, it would have been obvious to one having ordinary skill in the art at

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the time of the invention to add, to the filter 231, a flavoring agent, such as menthol, in order to provide a pleasing taste to the smoker while smoking the cigarette.

Regarding claim 2, since Gentry et al discloses that the filter materials of its inventive filter may have flavorants therein, it follows that since both segments 232 and 231 comprise the filter 230, each of said segments may be incorporated with a flavorant in order to provide a flavorful smoke for the user.

Regarding claim 3 and 11, it would have been obvious to one having ordinary skill in the art at the time of the invention to fabricate the filter segment 231 of conventional cellulose acetate filter tow, which is comprised of filaments. Incorporating a flavoring agent therein would result in the claimed "flavorant bearing filaments".

Regarding claims 4-6, Gentry states in col. 2, lines 44-49, states that the filter element can include two or more longitudinally positioned segments, and the segments can be combined in a variety of arrangements, but at least one must include carbonaceous material. This would motivate one of ordinary skill in the art to add at least one additional filter to the filter arrangement, and arrive at the claimed arrangement depending on the properties and the desired characteristics of the filter element. Also, since one of the segments requires that carbonaceous material be incorporated therein, one having ordinary skill in the art would have been motivated to provide, after routine experimentation, at least 85% filled filter segment in order to provide a filter with optimal gas-phase component reducing properties.

Regarding claims 13-15 and 32, Gentry et al discloses that the carbon material, which is highly activated, can range from 20-120 mg. Again, one of ordinary skill in the

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art, after routine experimentation, would have arrived at either a fully filled or 85% filled carbon filter segment in an effort to fabricate an optimal cigarette filter.

Regarding claims 33-34, Gentry et al discloses that its inventive filter achieves reductions in the claimed gas phase constituents (see col. 10, lines 47-59).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry et al (US. Pat. No. 5,568,819) in view of Raker et al (US. Pat. No. 5,261,425).

While the Gentry et al reference may not state that tobacco filter segments are of low particulate filtration efficiency, Raker et al states, generally, that low efficiency filter elements are desirable so that low "tar" yield is obtained as a result of high level filter ventilation, which inherently provide a means for reducing the yields of mainstream gaseous components (see col. 13, line 55 – col. 14, line 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide filter segments having low efficiency in order to achieve the benefits stated in Raker et al.

Allowable Subject Matter

9. Claims 8-10, 12, and 16-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

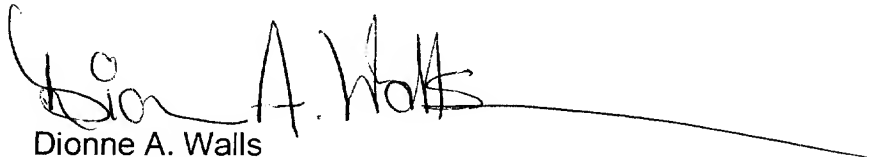
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-

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0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.


Dionne A. Walls
July 24, 2003